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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* LARRY A. GREENSPAN, STEVEN MICHAEL MALLOT, JON
9 DAVID FRIZZELL, DEBORAH LOUISE REED, and BRIAN HOWARD
10

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12 Appeal 2008-005442
13 Application 09/722,962
14 Technology Center 3600
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17 Decided: November 12, 2009
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21 Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and
22 BIBHU R. MOHANTY, *Administrative Patent Judges*.
23
24 FETTING, *Administrative Patent Judge*.
25
26

27 DECISION ON APPEAL

STATEMENT OF THE CASE

Larry A. Greenspan, Steven Michael Mallot, Jon David Frizzell, Deborah Louise Reed, and Brian Howard (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 61-71, 73, 74, 76-87, and 89-92, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We REVERSE.

The Appellants invented a way of generating a graphical case presentation of a course of treatment using a single mouse click to assemble all necessary information for a diagnosed case from a healthcare management application and consolidate the information into a concise and presentable form for the patient (Specification 1:Second full ¶). Essentially the invention is to a report generator that merges specific dental treatment information into a general treatment template.

An understanding of the invention can be derived from a reading of exemplary claim 61, which is reproduced below [bracketed matter and some paragraphing added].

61. A method for generating and tracking presentations for a dental patient describing a recommended course of dental treatment comprising of at least one dental procedure, the method comprising the steps of:

[1] providing and starting a presentation tool in a computer having a display;

[2] providing at least one master template configured for display as a dental presentation on said computer display; wherein said master template:

- (a) includes general information to be shown in every presentation;
 - (b) designates a common theme or look for the presentation;
 - (c) presents common information in a consistent manner on every presentation;
 - (d) controls the order of the information in the presentation; and
 - (e) reduces the possibility of errors in the information presentation;
- loading the dental presentation master template into the presentation tool;

[3] providing the dental presentation master template with at least one specific dental procedure indicator

for use as a point of incorporation for specific dental information on the recommended course of treatment;

[4] inserting in each template at least one general information indicator

for use as a point of incorporation for general information on the dental patient;

[5] incorporating specific dental information about the specific dental procedure from the recommended course of treatment for the dental patient into the template,

wherein incorporating specific dental information comprises the steps of

- i. scanning the template for a marker, wherein the marker identifies dental information specific to the dental patient and the marker identifies an insertion point in the template;
- ii. retrieving dental information specific to the dental patient identified by the marker from the dental desktop application;
- iii. inserting the retrieved dental information specific to the dental patient into the template at the insertion point identified by the marker; and
- iv. repeating the steps of scanning, retrieving and inserting for each marker in the template;

- [6] incorporating the general information on the dental patient into at least one template;
- [7] generating a dental presentation using at least one template with the incorporated specific dental information and the general information on the dental patient with one step, wherein the dental presentation is generated utilizing the computer;
- [8] storing the dental presentation in a dental desktop application on the computer;
- [9] presenting the dental presentation to the dental patient without presenting a graphic simulation of the treatment of the patient; and
- [10] updating records of the individual in the dental desktop application to correspond to the indicated at least one dental procedure accepted by the individual in the presentation tool.

This appeal arises from the Examiner's Final Rejection, mailed May 4, 2006. The Appellants filed an Appeal Brief in support of the appeal on February 1, 2007. An Examiner's Answer to the Appeal Brief was mailed on July 5, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Clark	US 6,171,112 B1	Jan. 9, 2001
Sachdeva	US 6,587,828 B1	Jul. 1, 2003

Roger C. Parker, *Microsoft 4 for Windows for Dummies*, 161-200 (1994) (hereinafter "Parker").

REJECTIONS

Claims 61-71, 73-74, 76-87, and 89-92 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure.

Claims 61-63, 66-71, and 73-74 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sachdeva, Clark, and Admitted Prior Art.

Claims 64 and 65 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sachdeva, Clark, Admitted Prior Art, and Parker.

Claims 76-87 and 89-92 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sachdeva, Parker, and Admitted Prior Art.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 61-71, 73-74, 76-87, and 89-92 under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 61-63, 66-71, and 73-74 under 35 U.S.C. § 103(a) as unpatentable over Sachdeva, Clark, and Admitted Prior Art.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 64 and 65 under 35 U.S.C. § 103(a) as unpatentable over Sachdeva, Clark, Admitted Prior Art, and Parker.

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 76-87 and 89-92 under 35 U.S.C. § 103(a) as unpatentable over Sachdeva, Parker, and Admitted Prior Art.

The pertinent issue turns on whether Sachdeva describes a template as in limitation [2] of claim 61.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of “template.”
02. The ordinary and customary meaning of “template” within a computer context is a document or file having a preset format, used as a starting point for a particular application so that the format does not have to be recreated each time it is used.¹

Sachdeva

03. Sachdeva is directed to automation of orthodontics treatment plan generation (Sachdeva 3:13-17).
04. Sachdeva describes processing that begins by providing a list of health care services to a patient and/or care provider. The processing continues by prompting for input of digital information regarding the patient when a health care service has been selected.

¹ *American Heritage Dictionary of the English Language* (4th ed. 2000).

1 The processing continues by determining whether a sufficient
2 amount of digital information has been received. If so, the
3 processing continues by simulating treatment of a patient based on
4 the digital information, a treatment objective, and normalized
5 patient data. The processing then continues by generating the
6 patient treatment plan in accordance with the simulating of the
7 treatment when the simulated treatment results have been
8 acknowledged. With such a method and apparatus, the generation
9 of a patient treatment plan may be automated for particular types
10 of health care services, including orthodontic care, dental care,
11 and medical care (Sachdeva 3:37-54).

12 05. Sachdeva's device receives information that may include one or
13 more of: the patient's chief complaint, the patient's medical
14 history, the patient's dental history, clinical examination, three-
15 dimensional images of the patient's orthodontic structure, video
16 graphic examination, functional examination information, soft
17 tissue evaluation, skeletal evaluation, and patient's objectives
18 (Sachdeva 4:12-17).

19 06. To facilitate the generation of its treatment plan, Sachdeva's
20 treatment plan device may interface with a medical resource, a
21 dental resource, an orthodontic resource, an insurance company,
22 and other resources. Based on input from one or more of these
23 sources and the inputs provided by the patient and local care
24 provider, the treatment plan device generates the treatment plan.
25 The treatment plan will include results, based on appearance,
26 function, costs of treatment, time for treatment, staging of

1 treatment events, evaluation periods, scheduling, and associated
2 risks (Sachdeva 4:49-60).

3 07. Sachdeva's Fig. 2 illustrates a logic diagram for generating a
4 patient treatment plan for a patient and may be implemented as
5 operational instructions for execution. The process begins with a
6 list of health care services on a graphical user interface. Once the
7 health care service has been selected, a prompt requests the user to
8 input digital information of an orthodontic patient such as a digital
9 model of the patient's malocclusion, patient's chief complaint,
10 patient's demands, financial constraints, treatment length, desired
11 orthodontic function, desired orthodontic appearance, the patient's
12 dental history, and the patient's medical history. Next a treatment
13 objective that may include dental appearance, orthodontic
14 function, facial appearance, skeletal appearance and/or function,
15 treatment time, patient's commitment to treatment, and costs. The
16 process then proceeds to where treatment of the patient is
17 simulated based on the received digital information, the treatment
18 objective, and normalized patient data (Sachdeva 5:11 – 6:15).

19 *Parker*

20 08. Parker is directed to explaining Microsoft Office (Parker:Title).

21 09. Each layout alternative is based on an underlying design or
22 template, called a Slide Master. That contains background text
23 and graphics that appear in each slide (Parker 192:Editing the
24 Slide Master).

25 10. PowerPoint presentations are saved in files (Parker 174:Saving
26 your work as a PowerPoint file).

1 *Clark*

2 11. Clark is directed to a Virtual Interactive Teaching and Learning
3 (VITAL) Center that provides an interactive patient education and
4 informed consent process that reduces patient anxiety, increases
5 patient comprehension and improves the level of personal
6 interaction between patient and physician (Clark 3:58-62).

7 *Facts Related To Differences Between The Claimed Subject Matter And*
8 *The Prior Art*

9 12. Sachdeva does not refer to or otherwise describe a master
10 template.

11 *Facts Related To The Level Of Skill In The Art*

12 13. Neither the Examiner nor the Appellants has addressed the level
13 of ordinary skill in the pertinent arts of systems analysis and
14 programming, graphical user interfaces, dental systems, document
15 presentation systems, and user interface design. We will therefore
16 consider the cited prior art as representative of the level of
17 ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350,
18 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the
19 level of skill in the art does not give rise to reversible error ‘where
20 the prior art itself reflects an appropriate level and a need for
21 testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v.*
22 *Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

23 *Facts Related To Secondary Considerations*

24 14. There is no evidence on record of secondary considerations of
25 non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

1 *Written Description*

2 The first paragraph of 35 U.S.C. § 112 requires that the specification
3 shall contain a written description of the invention. This requirement is
4 separate and distinct from the enablement requirement. *See, e.g., Vas-Cath,*
5 *Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

6 The “written description” requirement implements the principle
7 that a patent must describe the technology that is sought to be
8 patented; the requirement serves both to satisfy the inventor's
9 obligation to disclose the technologic knowledge upon which
10 the patent is based, and to demonstrate that the patentee was in
11 possession of the invention that is claimed.

12
13 *Capon v. Eshhar*, 418 F.3d 1349, 1357 (Fed. Cir. 2005).

14 One shows that one is “in possession” of *the invention* by
15 describing *the invention*, with all its claimed limitations, not
16 that which makes it obvious. *Id.* (“[T]he applicant must also
17 convey to those skilled in the art that, as of the filing date
18 sought, he or she was in possession *of the invention*. The
19 invention is, for purposes of the ‘written description’ inquiry,
20 *whatever is now claimed*.”) (emphasis in original). One does
21 that by such descriptive means as words, structures, figures,
22 diagrams, formulas, etc., that fully set forth the claimed
23 invention. Although the exact terms need not be used *in haec*
24 *verba*, *see Eiselstein v. Frank*, 52 F.3d 1035, 1038 . . . (Fed.
25 Cir. 1995) (“[T]he prior application need not describe the
26 claimed subject matter in exactly the same terms as used in the
27 claims . . .”), the specification must contain an equivalent
28 description of the claimed subject matter.

29
30 *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

31 *Obviousness*

32 A claimed invention is unpatentable if the differences between it and
33 the prior art are “such that the subject matter as a whole would have been

1 obvious at the time the invention was made to a person having ordinary skill
2 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 550
3 U.S. 398, 399 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

4 In *Graham*, the Court held that the obviousness analysis is bottomed
5 on several basic factual inquiries: “[1] the scope and content of the prior art
6 are to be determined; [(2)] differences between the prior art and the claims at
7 issue are to be ascertained; and [(3)] the level of ordinary skill in the
8 pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 550 U.S. at 406.

9 “The combination of familiar elements according to known methods is likely
10 to be obvious when it does no more than yield predictable results.” *Id.* at
11 416.

12 “When a work is available in one field of endeavor, design incentives
13 and other market forces can prompt variations of it, either in the same field
14 or a different one. If a person of ordinary skill can implement a predictable
15 variation, § 103 likely bars its patentability.” *Id.* at 417.

16 “For the same reason, if a technique has been used to improve one
17 device, and a person of ordinary skill in the art would recognize that it would
18 improve similar devices in the same way, using the technique is obvious
19 unless its actual application is beyond his or her skill.” *Id.*

20 “Under the correct analysis, any need or problem known in the field
21 of endeavor at the time of invention and addressed by the patent can provide
22 a reason for combining the elements in the manner claimed.” *Id.* at 420.

23

ANALYSIS

Claims 61-71, 73-74, 76-87, and 89-92 rejected under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure.

The Appellants argue the independent claims 61 and 76. Accordingly, we select claims 61 and 76 as representative. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that the Appellants introduced new matter because the original Specification used the term healthcare which was subsequently changed to dental. In particular, the Examiner found that the originally filed Specification did not contain support for limitations [4] and [5] of claim 61 or the equivalent to claim 61's limitation [5] in claim 76 (Answer 3-4).

The Appellants contend that they specifically enumerated dental procedures as a subset of healthcare in Specification pages 1-2 and that many of the drawings show the claimed subject matter using dental examples (Appeal Br. 6-7) and the Appellants show where the Specification supports the above claim limitations at Appeal Brief pages 2-4.

We agree with the Appellants. The original Specification supports limitations [4] and [5] of claim 61 as applied to healthcare at Specification 8-10. In particular, the Specification pages 8-9 describes inserting a procedure information page that generally describes the procedures for the patient, supporting limitation [4], and Specification pages 9-10 describes scanning to insert procedure details using marker codes supporting limitation [5]. Although these portions refer generically to healthcare procedures, we find that Figure 3 explicitly portrays such a presentation to dental procedures.

1 Thus we find the Appellants show possession of the claimed subject matter
2 at the date of filing.

3 The Appellants have sustained their burden of showing that the
4 Examiner erred in rejecting claims 61-71, 73-74, 76-87, and 89-92 under 35
5 U.S.C. § 112, first paragraph, as lacking a supporting written description
6 within the original disclosure.

7 *Claims 61-63, 66-71, and 73-74 rejected under 35 U.S.C. § 103(a) as*
8 *unpatentable over Sachdeva, Clark, and Admitted Prior Art.*

9 The Appellants argue these claims as a group.

10 Accordingly, we select claim 61 as representative of the group.
11 37 C.F.R. § 41.37(c)(1)(vii) (2007).

12 The Examiner found that Sachdeva described most of the limitations,
13 but did not describe the scanning, or recording of date and time. The
14 Examiner found that Clark described the recording of date and time and took
15 administrative notice of the notoriety of using markers such as link tags in
16 HTML documents to scan and import data (Answer 7-10).

17 The Appellants contend that Sachdeva does not show the claimed
18 template, markers, or one click updating to insert specific dental information
19 at the markers (Appeal Br. 8-9).

20 We agree with the Appellants. The Examiner found that Sachdeva
21 described a master template in Figure 1, reference numbers 18-20. We must
22 first construe the term “template” to determine whether this finding is in
23 error. The Specification does not define the term “template” but its usual
24 and customary meaning within a computer context is a document or file
25 having a preset format, used as a starting point for a particular application so

1 that the format does not have to be recreated each time it is used (FF 01 &
2 02).

3 Sachdeva Figure 1 shows an image of a screen shot. Reference
4 numbers 18-20 are graphic and textual content within the screen shot. There
5 is no description of this screen shot as a document or file. Indeed there is no
6 description of how the screen is assembled or whether such assembly is
7 stored as anything resembling a template.

8 The Examiner points to Sachdeva column 4, lines 11-60 to support
9 such a template (Answer 21:¶ (B))². This portion of Sachdeva describes
10 how the “treatment plan device” collects information. Apparently the
11 Examiner found the entire computer in Sachdeva to be the master template.
12 However, a computer is neither a document nor a file. The cited portion also
13 describes the individual contents of the screen as being stored in firmware,
14 but does not describe any file or document that collects those contents into
15 an organized structure that might be construed as a template. Thus we agree
16 that the Examiner was in error in finding that Sachdeva described a master
17 template (FF 12).

18 The Examiner further found that the scanning limitations of claim 61
19 were old and well known. The Examiner took administrative notice of the
20 notoriety of HTML documents that scan for documents matching hyperlinks.
21 The Examiner also found that there were no one step limitations in claim 61
22 (Answer 21-22:¶’s (C) and (D)).

² The Examiner also found that the Appellants argued that none of Sachdeva, Clark, or Parker described the template. The rejection of claim 61 to which the Examiner responded was over Sachdeva, Clark, and admitted prior art. Parker was not applied in the rejection of claim 61.

1 As to the one step limitation, this is in limitation [7]. The Examiner
2 made no finding as to how any art described this limitation. Thus we agree
3 the Examiner failed to establish a prima facie case.

4 As to the notoriety of HTML, as the Appellant argued, this is
5 inapposite to limitation [5] which scans for information for a specific
6 patient. The patient changes from presentation to presentation. The
7 conventional links in an HTML document the Examiner refers to scan for a
8 document meeting the identifier in the link, which would not change
9 between patients. Accordingly, the conventional links in an HTML
10 document would not identify dental information specific to the dental patient

11 The remaining claims depend from claim 61 and incorporate the
12 limitations of claim 61. The Appellants have sustained their burden of
13 showing that the Examiner erred in rejecting claims 61-63, 66-71, and 73-74
14 under 35 U.S.C. § 103(a) as unpatentable over Sachdeva, Clark, and
15 Admitted Prior Art.

16 *Claims 64 and 65 rejected under 35 U.S.C. § 103(a) as unpatentable over*
17 *Sachdeva, Clark, Admitted Prior Art, and Parker.*

18 The Examiner did not rely on Parker to describe any of the limitations
19 for which the findings in the rejection of claim 61 were in error. The
20 Appellants have accordingly sustained their burden of showing that the
21 Examiner erred in rejecting claims 64 and 65 under 35 U.S.C. § 103(a) as
22 unpatentable over Sachdeva, Clark, Admitted Prior Art, and Parker, for the
23 same reasons as against the rejection of claim 61.

24 *Claims 76-87 and 89-92 rejected under 35 U.S.C. § 103(a) as unpatentable*
25 *over Sachdeva, Parker, and Admitted Prior Art.*

1 This rejection includes the only other independent claim, claim 76,
2 which is drafted towards a system that performs the procedure recited in
3 claim 61. Thus claim 76 includes the limitations from claim 61 for which
4 the Examiner's findings were in error. The Examiner did not rely on Parker
5 to describe any of the limitations for which the findings in the rejection of
6 claim 61 were in error. The Appellants have accordingly sustained their
7 burden of showing that the Examiner erred in rejecting claims 76-87 and 89-
8 92 under 35 U.S.C. § 103(a) as unpatentable over Sachdeva, Parker, and
9 Admitted Prior Art, for the same reasons as against the rejection of claim 61.

10 11 CONCLUSIONS OF LAW

12 The Appellants have sustained their burden of showing that the
13 Examiner erred in rejecting claims 61-71, 73-74, 76-87, and 89-92 under
14 35 U.S.C. § 103(a) as unpatentable over the prior art.

15 16 DECISION

17 To summarize, our decision is as follows:

- 18 • The rejection of claims 61-71, 73-74, 76-87, and 89-92 under 35
19 U.S.C. § 112, first paragraph, as lacking a supporting written
20 description within the original disclosure is not sustained.
- 21 • The rejection of claims 61-63, 66-71, and 73-74 under 35 U.S.C. §
22 103(a) as unpatentable over Sachdeva, Clark, and Admitted Prior Art
23 is not sustained.
- 24 • The rejection of claims 64 and 65 under 35 U.S.C. § 103(a) as
25 unpatentable over Sachdeva, Clark, Admitted Prior Art, and Parker is
26 not sustained.

- The rejection of claims 76-87 and 89-92 under 35 U.S.C. § 103(a) as unpatentable over Sachdeva, Parker, and Admitted Prior Art is not sustained.

REVERSED

hh

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